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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/623,921

07/21/2003

Thomas A. Allison

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EXAMINER

BUGG, GEORGE A

ART UNIT

PAPER NUMBER

2636

DATE MAILED: 11/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/623,921

Applicant(s) **6**

ALLISON, THOMAS A.

Examiner

George A Bugg

Art Unit

2636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claims refer to a method, a system, and a program for configuring an electronic module, within a vehicle, based on a comparison between a first and second vehicle identification number. The Examiner would like to know for what purpose the module is being configured, and what the configuration process entails. Applicant's Specification merely repeats the words configured, configures, configuration, and configuring, without giving any additional information as to what exactly is taking place, and why the configuration of the electronic module is necessary. In addition, the Examiner would like to know what, exactly, the information in the configuration table is used for, and what exactly the electronic module parameter(s) represent. Furthermore, it seems claims 3, 9, and 14 are in conflict with claims 1, 7, and 12, in that the second VIN is stored in the vehicle, and then in the electronic module. Is it being stored in both

Art Unit: 2636

locations, or being transferred from one location to the other? The claim language of 3, 9, and 14 is confusing with respect to claims 1, 7, and 12. Much clarification on all points is needed.

3. An art rejection follows, based on the Examiner's understanding of the invention.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-3, 5-9, and 11-14 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent Publication No. US 2003/0188303 A1, to Barman et al.
6. With regard to claims 1, 7, and 12, Applicant claims ***“A method, a computer useable medium including a program, and a system for configuring an electronic module within a vehicle comprising: determining a first vehicle identification number stored in the electronic module; determining a second vehicle identification number stored in the vehicle; comparing the first vehicle identification number from the electronic module and the second vehicle identification number from the vehicle; and configuring the electronic module***

based on the comparison." In Section 10, of the Barman reference, an invention pertaining to the altering, or configuring, of the software of engine controllers, or electronic modules is disclosed. Section 11 further teaches upgrading or configuring an electronic module, or engine controller, with upgraded software based on a comparison between the current version of software, and the upgraded version, wherein current software is replaced by new or upgraded software based on differences between corresponding blocks of old and new software. Section 15 also states, that the configuration process may also require that an identification from the controller be matched with a second identification number, which may be a vehicle identification number. Barman discloses the determination of two VINs and configuring an electronic module based on the comparison of the two VINs. It should also be noted that Barman discloses, a method, a program, and a system or apparatus for carrying out what is disclosed.

7. As for claims 2, 8, and 13, the Barman reference discloses (Section 34) upgrading the software of the engine controller, or electronic module. It is the contention of the Examiner that upgrading the engine controller software, is synonymous with modifying an electronic module parameter, since features and/or parameters of the software will be changed upon upgrade.

8. With regard to claims 3, 9, and 14, Section 76 discloses an initialization process, or predefined configuration process, wherein two VINs are compared, one from the memory 30B of the reprogrammer, and the other from the engine controller of the vehicle. Inherently, the second VIN is stored in the electronic module.

9. As for claims 5 and 11, as explained above the first VIN is established during an initialization process, or start-up, or power-up of the engine controller.
10. As for claim 6, Section 3 discloses that engine controllers typically use non-volatile memory, such as E-PROM.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 4, 10, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Publication No. US 2003/0188303 A1, to Barman et al.
13. As for claims 4, 10, and 15 Barman teaches (Sections 77-82) a checksum and information from the controller being compared to parameters in memory 30 of the reprogrammer. If all initialization checks are successful, than an upgrade or modification to the system software, including parameters, takes place. While the Barman reference does not specifically disclose a configuration table, he does disclose pre-stored parameters and data, relating to an initialization process, or a predefined configuration process, and therefore it would have been obvious to one of ordinary skill in the art to utilize a configuration table for the purpose of processing and upgrading engine controller software and commands.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to George A Bugg whose telephone number is (571) 272-2998. The examiner can normally be reached on Monday-Thursday 9:00-6:30, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Hofsass can be reached on (571) 272-2981. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

George A Bugg
Examiner
Art Unit 2636

November 1, 2004


JEFFERY HOFSSASS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600